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REMARKS

Claims 109-156 are pending, with claims 109, 125, and 141 being independent. Claims 1-108 have been cancelled.

Rejections under 35 U.S.C. §103(a)

Claims 109-156 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Gerace (U.S. Patent No. 5,848,396) in view of Bharat (U.S. Patent Publication No. 2004/0267723). Applicant traverses the rejection.

Applicant asserts that, under U.S.C. §103(c), Bharat is disqualified as prior art to support a rejection under 35 U.S.C. §103(a). First, Bharat is only available as prior art under 35 U.S.C. §102(e) because Bharat was filed June 30, 2003, which is prior to July 22, 2003 (i.e., the effective filing date of the present application), and the earliest publication date for Bharat is December 30, 2004, which is after July 22, 2003. Second, the subject matter of Bharat and the claimed subject matter "were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person." For example, as of the filing date of the present application, Bharat was owned by Google Inc. and the inventors of the present application were obligated to assign the present application to Google Inc. Accordingly, Bharat is disqualified as prior art under §103(c). In view of the disqualification of Bharat, applicant request reconsideration and withdrawal of the rejection of claims 109-156.

Notwithstanding the disqualification of Bharat, applicant asserts that Gerace fails to support a rejection of claims 109-156 because Gerace fails to disclose at least one element of claims 109-156. Furthermore, it would not have been obvious to one of ordinary skill in the art to modify Gerace to arrive at the subject matter recited by claims 109-156. Applicant also asserts that the deficiencies of Gerace are not cured by Anderson (U.S. Patent Publication No. 2004/0093327) or Graham (U.S. Patent Publication No. 20060122884).

Claim 109

For at least the reasons set forth below, Gerace fails to support a rejection of claim 109 under 35 U.S.C. §103(a) because Gerace fails to disclose at least one element of claim 109, and it would not have been obvious to one of ordinary skill in the art to modify Gerace to arrive at the elements recited by claims 109.

At pages 4 and 5 of the office action the Examiner states:

> Gerace does not explicitly disclose for each identified concept, content-concept performance, and corresponding to the concept, using the concept performance, or performance based on concept.
> However, Gerace discloses tracking ad performance (12:55-65; 33:35-34:30) and improving ad performance targeting (20:8-20; 18:10-26). Gerace further discloses that ads are known for their type of information (3:4-7; 12:25-30) and that ads are placed based on the relevance of ad content to webpage content 16:35-55; 10:60-65; 14:25-35). And, Gerace discloses that the "Media (visible/playable here)" where an ad is shown is tracked (33:55-60). Also Gerace tracks every ad presented to a user and with what other content on the page the ad was presented (6:45-7:45). And, Gerace discloses that ads are presented so to be optimized both for relevant content and style (5:20-25).
> Gerace further discloses correlating page content and ad content:
> "A Page object 35a cross references a User Interface Object 37c which specifies which Page Display Object 35a and which agate information (content and presentation) is appropriate for the current user. Page Data Objects 35b hold the agate or other data to be displayed to end users. Included are advertisements (objects themselves) which may be integrated into the agate data. Preferably advertisements are positioned along the periphery (i.e., above, below, left or right) of the agate data, as defined by a respective Page Display Object 35c. Accordingly, Page Data Objects 35b support Page Display Objects 35c which outline the possible screen content and presentation formats in which agate data advertisements are to be displayed." (7:18-37).
> Based on these recorded details, program 31 constantly and automatically tailors screen views (content and presentation) and advertisement selection (subject matter and presentation) for the user. (17:1-17). (emphasis removed).

The Examiner states that, based on the foregoing, "it is obvious that Gerace can track performance for different page content/concepts and ad content relevance," and that "one would be motivated to do this to better target relevant ads." Applicant disagrees.

First, applicant notes that the Examiner appears to analyze a series of phrases that each are selected from different locations of claim 109 and to summarily address these phrases without considering their context. For example, the Examiner appears to analyze "using concept

performance" in isolation from the text that this phrase modifies (i.e., "modifying ... the initial advertisement performance information for an advertisement using the concept performance information.") According to MPEP 2106, "when evaluating the scope of a claim, every limitation in the claim must be considered. **USPTO personnel may not dissect a claimed invention into discrete elements and then evaluate the elements in isolation.** Instead, the claim as a whole must be considered." "**This is particularly true in a process claim because a new combination of steps in a process may be patentable even though all the constituents of the combination were well known and in common use before the combination was made.**" (emphasis added). Diamond v. Diehr, 450 U.S. 175, 188-89, 209 USPQ 1, 9 (1981). Thus, analyzing the phrase "using concept performance," without considering the process step for which the "content performance" is used is improper. Accordingly, applicant requests that the phrases "for each identified concept, content-concept performance, and corresponding to the concept, using the concept performance, or performance based on concept," be analyzed in view of the claim as a whole.

Second, even assuming that the Examiner's interpretations of the claim language and Gerace are proper (which applicant does not concede), claim 109 is not rendered obvious by Gerace. For example, in view of Gerace, it would not have been obvious to one of ordinary skill in the art to modify "the initial advertisement performance information for an advertisement using the concept performance information," as recited by claim 109, where the advertisement performance specifies "a measure of performance computed based on previous presentations of the advertisement," and the "concept performance information represent[s] an aggregate performance of advertisements that were presented with the document and corresponding to the concept."

At pages 2 and 3 of the office action, the Examiner states "Gerace discloses a method, comprising ... modifying ... the advertisement performance information for at least one of the one or more advertisements using the determined content concept performance information for the content concept associated with the at least one of the one or more advertisements (18:10-26)."

At column 18, lines 1-26 Gerace recites:

As discussed above, sponsors have the ability to place ads according to demographic profile. To do so, advertisers/sponsors complete a template, (preferably in the Ad Series Objects 33c) which allows them to list certain criteria as required, and to weight other criteria by importance. To ensure ads are shown to the appropriate target users, the sponsor then selects a minimum total weight which a user's demographic/psychographic profile must achieve before the advertisement is shown to the user.

To ensure that sponsors achieve the optimal result from the ads they place, program 31 combines regression analysis with the above weighting technique to achieve real-time, automatic optimization as discussed previously. Under this auto-targeting system, an ad package is shown to general users. After a large number (e.g., 10,000) hits, program 31 runs a regression on a subject Ad Package Object 33b to see what characteristics are important, and who (type of user profile) the ad appeals to the most. Program 31 then automatically enters weighting information based on that regression to create a targeted system and runs the advertisement (Ad Package Object 33b) again in front of this new targeted group. Program 31 then runs a regression every 10,000 hits, for example, including a group of 500 general people as a control, and adjusts the weighting. This continues until the Ad Package is exhausted (i.e., the number of hits and click throughs are achieved.

This portion of Gerace does not teach, describe, or suggest "modifying, by at least one processor, the initial advertisement performance information for an advertisement using the concept performance information for an identified concept corresponding to the advertisement." At most, this portion of Gerace discloses that "after a large number (e.g., 10,000) hits, program 31 runs a regression on a subject Ad Package Object 33b [i.e., an advertisement] to see what characteristics are important, and who (type of user profile) the ad appeals to the most. Program 31 then **automatically enters weighting information based on that regression** to create a targeted system and runs the advertisement."

As described by Gerace, advertisers are provided "the ability to place ads according to demographic profile" by "completing a template, (preferably in the Ad Series Objects 33c) which allows them to list certain criteria as required, and to weight other criteria by importance." At column 12, lines 28-31, Gerace notes that "the sponsor specifies in Ad Series Object 33c the required and/or preferred psychographic and/or demographic criteria and relative importance (e.g., weight) with respect to each criterion." Thus, the criteria that are weighted by Gerace are "psychographic and demographic criteria" for target users. Therefore, the "automatically

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enter[ed] weighting information" of Gerace is weighting information for "psychographic and demographic criteria," which are not the same as the "initial advertisement performance information" because the "psychographic and demographic criteria" of Gerace **do not** specify "a measure of performance computed based on previous presentations of the advertisement," as recited by claim 109. Rather, the "psychographic and demographic criteria" represent "characteristics of users." Gerace at Col. 2, line 47. These user characteristics are for targeting advertisements rather than measuring performance of advertisements. Accordingly, "automatically entering weighting information [for psychographic and/or demographic criteria] based on that regression," does not teach, describe, or suggest, "modifying … the initial advertisement performance information for an advertisement using concept performance information for an identified concept corresponding to the advertisement," as recited by claim 109.

Gerace also fails to provide any teaching that would make it obvious to one of ordinary skill in the art to modify Gerace to arrive at the method of claim 109. For example, based on the disclosure of Gerace, it would not be obvious to one of ordinary skill in the art to modify "the initial advertisement performance information for an advertisement using the concept performance information for an identified concept corresponding to the advertisement," as recited by claim 109.

As discussed above, the Examiner states that for the reasons provided at pages 4 and 5 of the office action "it is obvious that Gerace can track performance for different page content/concepts and ad content relevance," and that "one would be motivated to do this to better target relevant ads." Applicant disagrees.

Even assuming that the Examiner's interpretation of Gerace is proper (which applicant does not concede), absent the teaching of the present application, the Examiner has not demonstrated that disclosing "tracking ad performance … improving ad performance targeting … that ads are known for their type of information … ads are placed based on the relevance of ad content to webpage content … where an ad is shown is tracked … track[ing] every ad presented to a use with what other content on the page the ad was presented … [and that] ads are presented so to be optimized both for relevant content and style," would lead one of ordinary skill in the art to modify "the initial advertisement performance information for an advertisement

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using the concept performance information for-an identified concept corresponding to the advertisement," where the "advertisement performance information for each advertisement specify[ies] a measure of performance computed based on previous presentations of the advertisement," and where "concept performance information represent[s] an aggregate performance of advertisements that were presented with the document and corresponding to the concept," as recited by claim 109.

For example, the office action fails to demonstrate that there is any explicit or implicit teaching, suggestion, or motivation to modify Gerace to arrive at claim 109. Rather, the office action merely recites that "one would be motivated to do this to better target relevant ads." While "targeting relevant ads" may be a goal of advertisement targeting, there are many different ways in which one of ordinary skill in the art can attempt to achieve better "targeting" of "relevant ads." Thus, the goal of "better targeting relevant ads" alone does not provide "a clear articulation of the reason(s) why the claimed invention would have been obvious," as required to support a Prima Facie case of obviousness. MPEP § 2143.

For at least the reasons provided above, Gerace fails to support a rejection of claim 109 under §102 or §103, because Gerace fails to describe at least one element of claim 109, and, based on the disclosure of Gerace, it would not have been obvious to modify Gerace to arrive at the subject matter of claim 109. Accordingly, applicant asserts that claim 109 and its dependent claims are allowable over Gerace.

The Examiner has noted that, while not relied upon, Anderson (U.S. Patent Publication No. 2004/0093327) and Graham (U.S. Patent Publication No. 2006/0122884) disclose "concept/topic for documents and presenting relevant ads (Fig. 1c; 9a; claim 27)." With reference to Anderson, applicant asserts that Anderson is disqualified under §103(c) for the same reasons described above with reference to Bharat. For example, Anderson is only available under §102(e) because the earliest effective filing date for Anderson is September 2, 2002, which is prior to July 22, 2003 (i.e., the effective filing date of the present application), and the earliest publication date for Anderson is March 15, 2004, which is after July 22, 2003. Additionally, as of the filing date of the present application, the inventors of Anderson and the inventors of the present application were each under an obligation to assign the respective applications to Google Inc. Accordingly, Anderson is disqualified as prior art under §103(c)

With reference to Graham, applicant asserts that Graham fails to cure the deficiencies of

Gerace. Claim 27 of Graham recites:

> An apparatus for determining if an advertising is relevant to a web
> document, the apparatus comprising:
>   at least one memory having program instructions;
>   at least one processor configured to execute the program instructions to
> perform operations of:
>   identifying one or more advertisement-related concepts corresponding to
> the advertisement;
>   analyzing content of the web document to identify one or more document-
> related concepts for the web document;
>   comparing the one or more advertisement-related concepts to the one or
> more document-related concepts to determine if a match exists; and
>   determining that the advertising is relevant to the web document if a match
> exists.

According to claim 27, "advertisement-related concepts" are compared to "document-

related concepts to determine if a match exists," and a determination is made "that the

advertising is relevant to the web document if a match exists." Graham's "comparing ...

advertisement-related concepts to ... document related concepts to determine if a match exists,"

even when combined with the disclosure of Gerace, does not result in the elements of claim 109.

For example, the combination of Gerace and Graham still fails to disclose "modifying, by at least

one processor, the initial advertisement performance information for an advertisement using the

concept performance information for an identified concept corresponding to the advertisement,"

as recited by claim 109. Additionally, Gerace and Graham provide no teaching, suggestion, or

motivation to modify the combination of Gerace and Graham to arrive at claim 109.

Accordingly, applicant asserts that claim 109 and its dependent claims are allowable over

Gerace, Graham, and combinations thereof.

Claim 125

For at least the reasons provided with reference to claim 109, claim 125 is allowable over

the art of record. For example, the relied-upon art fails to teach, describe, suggest, or render

obvious the elements of claim 125. Accordingly, applicant requests reconsideration and withdrawal of the rejection of claim 125 and its dependent claims.
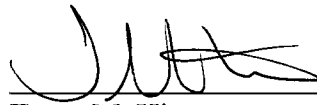
Claim 141

For at least the reasons provided with reference to claim 109, claim 141 is allowable over the art of record. For example, the relied-upon art fails to teach, describe, suggest, or render obvious the elements of claim 141. Accordingly, applicant requests reconsideration and withdrawal of the rejection of claim 141 and its dependent claims.

Please apply any charges or credits to deposit account 06-1050.

Respectfully submitted,

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